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| RALPH E. JOCKE | | | EXAMINER | |
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERY M. ENRIGHT, KEVIN F. MARTIN,
BRAD STEPHENSON, ROY HATHAWAY,
TOM KEHNER, CHRIS KNOUFF, KEN VARN,
JEFF THOMAS, JAY PAUL DRUMMOND,
JOHN KORTIS, DAVID A. CRANE, EVAN F. GOLDRING,
ROBERT NOVITSKEY, MIKE RUSSELL,
MICHAEL MOTT, CHRIS DIVITA, and DOUG WILLIAMS

Appeal 2007-3366
Application 09/414,290
Technology Center 3600

Decided: July 17, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and JOHN C. KERINS,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

Jeffery M. Enright, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-43. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We find that the appeal is not in a condition for meaningful review. We remand the application to the Examiner with instructions that the Examiner step back and re-assess the grounds of rejection in light of the following remarks.

The following rejections have been put before us for review:

1. Claims 1-9, 13, 17, 22, and 25-43 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eisenberg and “Java Goes Full Circle”.
2. Claims 10-11, 14-16, 18-21, and 23-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eisenberg, “Java Goes Full Circle”, and Hoang.
3. Claim 12 is rejected under 35 U.S.C. § 103(a) as unpatentable over Eisenberg, “Java Goes Full Circle”, Hoang, and Wookey.

These are the statements of the rejections as they are set forth in the Appeal Brief (p. 8) and the Answer (see pages 4, 23, and 30).

However, there are three references listed as evidence relied upon (see Answer 3) that have not been included in any statement of the rejection. The are:

- McManus, Kevin, “Eye for an Eye at ATMs of Future.” Washington Post, Buffalo News, Buffalo, N.Y., May 19, 1996, p. F.12.
- Barthel, Matt, “Digital storage weighed for ATM surveillance,” American Banker, New York, N.Y., Feb. 22, 1994, p. 20.
- Anonymous, “Digital tape storage predicted to grow ‘astronomically’,” Security, Troy, Jul. 1997, Vol. 34, Issue 7, p. 46, 2 pages.

These references have been used as part of the response to the arguments made in the Appeal Brief. They appear to have been used to overcome weaknesses in the

Examiner's initial *prima facie* case of obviousness. The Examiner states: "As further evidence that image data is part of transaction data, and was readily stored in such databases the examiner submits the McManus reference as evidence." (Answer 33). However, we see no discussion in the grounds of rejection about image data being a part of transaction data. (See Answer 4-6). Similarly, the Examiner states: "the examiner believes [Barthel and Anonymous] makes up for the technology deficiencies of Eisenberg and supports his finding of obviousness with respect to claim 1 of the present invention." (Answer 36).

We agree with the Appellants that the Examiner's use of these three references in the manner discussed in the Answer amounts to a new ground of rejection. (See Reply Brief 12 and 22).

We recognize the Examiner's detailed and comprehensive analysis of the claimed invention and the prior art. We understand the Examiner to be arguing that various limitations in the claims are conventional. However, in order to give the Appellants an opportunity to respond, all the aspects which the Examiner has determined to be well known should be spelled out in the initial *prima facie* case of obviousness, and not developed for the first time in response to arguments made in the Appeal Brief.

Furthermore, we commend *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), which issued after the Reply Brief was filed, to the attention of the Examiner. This decision is especially relevant to the facts of this case because the issue would appear to be whether the combination of known elements would have been obvious to one of ordinary skill in the art. The Examiner should re-evaluate

the obviousness of the claimed invention in light of the reasoning used in *KSR* and present a *prima facie* case of obviousness, if warranted, that not only spells out all the features of the claimed invention which the Examiner finds well known or described in cited references, and their functions, but also articulates an apparent reasoning logically underpinned for making the claimed combination.

The Examiner should be mindful that “[s]ection 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR* at 1734. The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18.

The Supreme Court decision in *KSR* clarified the test for obviousness. In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious

without an explicit application of the teaching, suggestion, motivation test. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *Id.* (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

The question of whether an improvement is more than the predictable use of prior art elements according to their established functions is relevant here, given the fact that many if not all the elements of the claimed apparatus appear to be well known in the art at the time of the invention. “When a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1739 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532 (1976)). In light of *KSR*, to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), it is sufficient to show that the claimed system is the combination of prior art elements according to known methods to yield predictable results.

That is not to say that all arrangements of prior art elements are necessarily obvious. As the Supreme Court made clear with respect to the facts before it in *KSR*, “[f]ollowing these principles may be more difficult in other cases than it is

here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741.

We remand the application to the Examiner for reconsideration of the rejections in light of and not inconsistent with the remarks made herein.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection.

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Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

JRG

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